

REMARKS

Claims 1-22 were previously pending in the application with claims 1, 10 and 18 being the independent claims. Paragraphs [0027 and 0030] of the specification has been amended to correct typographical errors. No new matter has been added by way of the foregoing amendments. Reconsideration of presently pending claims 1-22 is respectfully requested in light of the above amendments and the following remarks.

Allowable Subject Matter

Noted with appreciation is the indication that claim 21 is directed at allowable subject matter and would be allowed if rewritten in independent form. However, it is respectfully submitted that claim 21 depends from a rejected base claim that is believed to be allowable for the reasons set forth below. Therefore, it is believed that is unnecessary to place claim 21 in independent form at this time.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 4 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by McDonald (U.S. Patent No. 6,530,065, hereinafter referred to as “McDonald”). Applicants respectfully traverse the rejections.

The PTO provides in MPEP § 2131 that “[t]o anticipate a claim, the reference must teach every element of the claim....” Therefore, with respect to claim 1, to sustain this rejection the McDonald reference must contain all of the above claimed elements of the claim. It is respectfully submitted that McDonald fails to teach a method for generating a primary document for a device in a semiconductor manufacturing environment that includes the steps of “creating a design rule that defines a relationship between first and second technologies,” and “applying the design rule to identify a corresponding device in the second technology,” as is recited in claim 1.

With regard to the limitation of “creating a design rule that defines a relationship between first and second technologies,” the Examiner indicated that McDonald allegedly discloses such a limitation in Col. 4, lines 41-67. Applicants respectfully disagree. The cited passage of McDonald recites the following:

... engineers designing products with electrical components. In one embodiment, generally referred to herein as “WEBSIM,” allows manufacturers of analog and mixed signal semiconductor devices to provide online design centers that allow end users to quickly select, try and evaluate the manufacturer’s products. WEBSIM integrates modeling technology, simulation capability, and an easy-to-use browser interface

that allows designers or users to select products on a manufacturer's website to evaluate and modify circuit values assumed in a circuit configuration, simulate assumptions or modifications, and immediately receive resulting waveforms online. The designer or user needs no special software or hardware other than a web browser. Furthermore, WEBSIM provides dynamic interactive data about semiconductor products more rapidly and at less cost than traditional marketing efforts.

As explained herein, aspects of the invention permit manufacturers to provide dynamic information on products of interested users, gather information about customer's requirements, maintain control of the device evaluation experience, create positive customer (and user) experience at manufacturers' web sites, support smaller customer accounts with cost savings and virtual tools, quickly generate worldwide impact via the Internet, and enjoy a single easily maintained point of control of device data on the Internet. (Emphasis added).

From the highlighted above, McDonald generally describes an online semiconductor design tool that allows semiconductor manufactures to provide online design centers that allow their customers to select, try, and evaluate the manufacturer's products. Specifically, the online design tool, WEBSIM, "integrates modeling technology, simulation capability, and an easy-to-use browser interface" that allows users to select products on the manufacturer's website, simulate assumptions and modifications of a circuit design, and immediately receive resulting waveforms online. However, nowhere in the cited passage does it disclose the feature of "creating a design rule that defines a relationship between first and second technologies." For at least this reason, the McDonald reference is insufficient to anticipate claim 1, and thus the rejection of claim 1 under 35 U.S.C. §102 should be withdrawn.

With regard to the limitation of "applying the design rule to identify a corresponding device in the second technology," the Examiner indicated that McDonald allegedly discloses such a limitation in FIG. 2B. Applicants respectfully disagree. First, since the McDonald reference fails to disclose the feature of "creating a design rule that defines a relationship between first and second technologies" as discussed above, the McDonald reference is precluded from disclosing the feature of "applying the design rule to identify a corresponding device in the second technology." Additionally, the pertinent excerpt of McDonald describing FIG. 2B (shown below) recites the following:

An example of a table stored in the database table 136 is shown in FIG. 2B. As shown, each row of the table corresponds to a particular device and flavor. The device LM2678 has four flavors and thus occupies four

rows of the table. Associated with each device and flavor is a Cgi_display, a layout file, a template file, a CGI-create file (described below), a simulator and a code base. (McDonald, Col. 7, lines 53-59) (emphasis added)

DB table example

# Device	Flavor	Cgi-display	Layout file	Template file	Cgi-create	Simulator	codebase
LM2678	5V	Print_html.cgi	Lm267x.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2678	12V	Print_html.cgi	Lm267x.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2678	3.3V	Print_html.cgi	Lm267x.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2678	ADI	Print_html.cgi	Lm267x.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2675	5V	Print_html.cgi	Lm267x.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2671	ADI	Print_html.cgi	Lm2671.layout	267x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm267x
LM2585	5V	Print_lm2585.cgi	Lm258x.layout	258x.tpl	Dock.prj	Simplis	webench/switching_regulator/lm258x
LP2966	5V	Print_lp296x.cgi	Lp296x.layout	Lp2966	SpDack.pr	SPICE	webench/switching_regulator/lp296x

Fig. 2B

From the highlighted above and illustrated in FIG. 2B, it is clear that McDonald discloses a table that is stored in a database that includes various semiconductor products and the corresponding files and/or programs associated with that particular product. For example, each product is associated with a Cgi_display, a layout file, a template file, a CGI-create file, a simulator, and a code base. Here, in contrast, claim 1 requires “applying the design rule” that defines a relationship between first and second technologies “to identify a corresponding device in the second technology.”

Accordingly, McDonald by disclosing a database that includes a list of semiconductor products and corresponding files and/or programs associated with each particular product, fails to disclose the feature of “applying the design rule” that defines a relationship between first and second technologies “to

identify a corresponding device in the second technology,” as is recited in claim 1. Therefore, the McDonald reference is insufficient to anticipate claim 1, and the rejection of claim 1 under 35 U.S.C. §102 should be withdrawn.

Claims 4 and 9 depend from and further limit independent claim 1, and thus are allowable for at least the same reasons set forth above in claim 1.

Claim Rejections – 35 U.S.C. § 103

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over McDonald, as applied to Claim 1 above, and further in view of Chuang (U.S. Patent No. 7,246,240, hereinafter referred to as Chuang). Claim 3 was rejected under 35 USC 103(a) as being unpatentable over McDonald, as applied to Claim 1 above, and further in view of Chen (U.S. Patent No. 7,263,477, hereinafter referred to as Chen). Claims 5-7, 10, 14 and 17 were rejected under 35 USC 103(a) as being unpatentable over McDonald in view of Chisaka (U.S. Patent No. 5,623,655). Claim 8 was rejected under 35 USC 103(a) as being unpatentable over McDonald, as applied to Claim 1 above, and further in view of Chisaka and Chen. Claims 11-13, 18-20 and 22 were rejected under 35 USC 103(a) as being unpatentable over McDonald in view of Chisaka and Kunitake (U.S. Patent No. 7,069,501, hereinafter referred to as Kunitake). Claims 15-16 were rejected under 35 USC 103(a) as being unpatentable over McDonald in view of Chisaka and Chen.

With regard to claims 2, 3, 5-7, 8, Applicants respectfully traverse the rejections on the grounds the McDonald reference is defective in maintaining a *prima facie* case of obviousness with respect to claim 1, from which the claims depend from.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a *prima facie* case of obviousness for the following reasons. McDonald cannot be applied to reject claim 1 under 35 U.S.C. § 103(a) which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be considered. However, the McDonald reference does not disclose nor suggest, all the claim limitations of claim 1 as was discussed above.

Accordingly, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection to claims 2, 3, 5-7, 8, which depend from and further limit claim 1, under 35 U.S.C. §103(a) should be withdrawn.

With regard to claim 10, Applicants traverse this rejection on the grounds that these references are defective in maintaining a *prima facie* case of obviousness.

In *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that “a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art**. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does**. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a *prima facie* case of obviousness does not exist for claim 10 for the reasons set forth below.

The Examiner has not shown how the elements being combined are performing their known or established function

KSR teaches that when combining elements from different references, it is important to determine whether the element is performing “the same function it had been known to perform.” *KSR* at 1740. It is clear that notifying a second user that a shared document has been updated by a first user, as taught in Chisaka, should not be combined with the McDonald reference because the function of providing an online design tool, WEBSIM, that allows users to select, try, and evaluate a semiconductor manufacturer’s products is changed. More particularly, the Examiner points to Col. 9, lines 46-62 of McDonald as allegedly disclosing the features of “updating information defining the common element with respect to the first device,” and “generating a primary document for the first device based on the updated information.” (Office Action, pg. 8). The cited passage of McDonald recites the following:

Referring back to FIG. 1B, in block 154 the server 100 receives the request for a simulation and invokes a “Process_sim.cgi” code block that, in turn, invokes two sub-processes to create a valid simulation netlist, invoke a simulator and process the simulator output. This occurs when the user clicks a “Go” button described below or “simulate” button described above. The first sub-process, “Cgi_create” (block 156), retrieves HTML parameters associated with the schematic, such as component parameters and type of test, and provides the parameters to, or creates, a .tlp file for generating a valid simulation netlist 158 (also referred to as a “deck”). The Process_sim.cgi code also initiates the simulator (block 160) to which the netlist is provided, and the simulator generates result files 162, based on the component parameters, test type, etc. and the netlist. The simulator may be commercially available simulators, such as PSPICE or SIMPLIS. (emphasis added)

From the highlighted above, McDonald discloses the process of generating results from a user initiated simulation of a circuit design. Accordingly, a first user may specify various parameters associated with the manufacturer’s semiconductor products that are being used in a first circuit design to simulate the circuit design. Thus, the first user can evaluate the resultant waveform (from the simulation) to determine whether the manufacturer’s products meet the user’s performance requirements. However, a second user may also specify various parameters associated with the manufacturer’s semiconductor products that are being used in a second circuit design to simulate and evaluate the manufacturer’s products. The manufacturer’s semiconductor products on WEBSIM are available to end users to select, try, and

evaluate. As such, the McDonald reference discloses that the online design tool, WEBSIM, is to provide dynamic information on products of interested users and a single, easily maintained point of control of device data on the Internet. (See McDonald, Col. 4, lines 58-67). There would be no reason to modify the online design tool, WEBSIM, of McDonald to include the feature of notifying the second user that a shared document (or any other document) has been updated by the first user, as is taught in Chisaka.

Since this modification of the McDonald reference clearly destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. Accordingly, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection to claim 10 under 35 U.S.C. §103(a) should be withdrawn.

The Examiner has not shown that all words in the claim have been considered

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, all words in the claim have not been considered. The Examiner indicated that “McDonald does not teach expressly sending a notification that the common element has been updated with respect to the first device and determining whether to update the common element with respect to the second device.” (Office Action, pg. 9). Accordingly, the Examiner points to the Abstract of the Chisaka reference to cure the deficiencies of McDonald. Applicants respectfully disagree. Specifically, the Examiner indicated that “Chisaka teaches sending a notification to a user to indicate that a shared document has been updated (See Chisaka, Abstract).” (Office Action, pg. 9). Further, the Examiner indicated “[w]hile Chisaka does not teach that the notification states the second technology should be updated, it would have been obvious to one of ordinary skill in the art to update the second technology to reflect the correct information contained in the primary document, providing the benefit of keeping all technologies current and up-to-date for future reference.” (Office Action, pg. 9).

However, claim 10 requires the features of “sending a notification that the common element has been updated with respect to the first device,” and “determining whether to update the common element with respect to the second device.” Accordingly, the common element with respect to the second device within a second technology may or may not be updated. In one example, the present application indicates in paragraph [0024] that “notification may be sent to ‘owners’ of (e.g., those responsible for) the related technologies to inform them of changes that have occurred [and the] owner of each identified SPICE model having that component may be notified and given the option of making similar change in their own model, or not making the change.”

Thus, for this independent reason, the McDonald and Chisaka references do not support a *prima facie* case of obviousness with respect to claim 10, and the rejection of claim 10 under 35 U.S.C. §103 should be withdrawn. Further, claims 11-17 depend from and further limit independent claim 10, and thus are allowable for at least the same reasons as set forth above in claim 10.

With regard to claims 18-20 and 22, independent claim 18 was rejected under 35 USC 103(a) as being unpatentable over McDonald in view of Chisaka and Kunitake. The Examiner indicated that “McDonald does not teach expressly a primary document assembly engine for generating the primary document, the engine adapted to execute a plurality of instructions including ... instructions for notifying a user responsible for the second device that the common element has been updated with respect to the first device.” (Office Action, pg. 14). The Examiner points to the Abstract of Chisaka as allegedly curing the deficiencies of McDonald as teaching “sending a notification to a user to indicate that a shared document has been updated. (Office Action, pg. 14). However, the combination of McDonald and Chisaka is improper as was discussed above in claim 10. Accordingly, Applicants respectfully submit that claim 18 is allowable. Claims 19-20 and 22 depend from and further limit claim 18, and are allowable as well. Therefore, the rejection of claims 18-20 and 22 under 35 U.S.C. §103 should be withdrawn.

Conclusion

An early formal notice of allowance of claims 1-22 is requested. The Examiner is invited to telephone the undersigned if further assistance is necessary. Deposit account number 08-1394 can be used for any over payments or under payments.

Respectfully submitted,



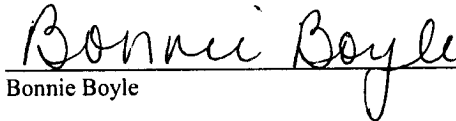
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